



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

ID

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/582,951 07/07/00 PETTIT

G 5379-US

RICHARD R MYBECK
POST OFFICE BOX 5540
SCOTTSDALE AZ 85261-5540

HM22/0608

EXAMINER

LUKTON, D

ART UNIT

PAPER NUMBER

1653

DATE MAILED:

06/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/582,951

Applicant(s)

Pettit

Examiner

David Lukton

Art Unit

1653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 7, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

Pursuant to the directives of paper No. 7 (filed 5/7/01), claims 1-8 have been amended, and claims 9-15 added. Claims 1-15 are pending.

Applicants' arguments filed 5/7/01 have been considered and found persuasive in part.

*

The specification is objected to. On page 4, line 18, the following is present:

"are described in copending US applications SN * _____ * ".

If this is to be retained, a serial number will be required.

*

The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The previously imposed rejection is withdrawn, as it was applied to claims 1 and 3-8. However, it is maintained against claim 2; this claim could be interpreted as being drawn to a method of treating fungal infections, a method which is not enabled.

As for the remaining claims, a new ground of rejection is now imposed. It is that the claims encompass processes in which neither the time, nor the conditions are effective to inhibit fungal growth. This ground of rejection can be overcome by amending claim 1 to recite that the time, and conditions are indeed effective to inhibit fungal growth.

Any of the following is suggested:

A method of inhibiting fungal growth in a host comprising administering to a host infected with fungi a compound selected from the group consisting of formulae 1a, 1b, 1c, 1d, and 1e for a time and under conditions effective to inhibit said fungal growth, wherein the structures of said formulae are as follows: ...

A method of inhibiting fungal growth in a host that is infected with fungi comprising administering to said host a composition, for a time and under conditions effective to inhibit said fungal growth, wherein said composition comprises an acceptable carrier together with a compound selected from the group consisting of formulae 1a, 1b, 1c, 1d, and 1e; and wherein the structures of said formulae are as follows: ...

A method of inhibiting growth of a fungus in a host that is infected with a fungus comprising administering to said host a compound selected from the group consisting of formulae 1a, 1b, 1c, 1d, and 1e, wherein said method, said compound is administered to the host for a time and under conditions effective to inhibit said fungal growth; and wherein the structures of said formulae are as follows: ...

A method of inhibiting growth of a fungus in a host that is infected with a fungus comprising administering to said host a composition comprising an acceptable carrier, and a compound selected from the group consisting of formulae 1a, 1b, 1c, 1d, and 1e, wherein said method, said composition is administered to the host for a time and under conditions effective to inhibit said fungal growth; and wherein the structures of said formulae are as follows: ...

*

Claims 1-15 are rejected under 35 U.S.C. ?112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 recites that the "carrier" and the compound are administered to the host. Are these to be administered separately? If not, then the claim should be amended to recite that it is a composition that is administered.
- Claim 1 is indefinite as to the process steps and endpoint. It is suggested that the claim be amended to recite that the time and under conditions of the administration are effective to inhibit the fungal growth.
- In claim 2, the term "said fungi" lacks antecedent basis. In ^{addition} ~~addition~~, it appears that *cryptococcus neoformans* should be referred to as a fungus (singular) rather than fungi (plural).
- In claim 3, the term "said fungi induced infections" lacks antecedent basis.
- In claim 8, there should presumably be a comma after "petrolatum".
- In claim 8, the following is recited:

"...said carrier comprises a water-and-oil emulsion, petrolatum, mineral oil, a moisturizer, a solubilizer, and fragrance".

The way this claim reads, all of the listed ingredients must be present. If this is not intended, the following claims could be recited instead:

16. *The method... wherein said carrier is selected from the group consisting of a water-and-oil emulsion, petrolatum, mineral oil, a moisturizer, and a solubilizer*

17. *The method... wherein said carrier comprises a fragrance, together with petrolatum, mineral oil, a moisturizer, or a solubilizer.*

18. *The method... wherein said carrier comprises a water-and-oil emulsion together*

with a fragrance.

However, if applicants retain the claim language the way it is, this will raise questions. How exactly is petrolatum and mineral oil compatible with water-and-oil emulsion...? Clearly, a water-and-oil emulsion contains an oil; is the petrolatum and mineral oil instead of, or in addition to, the oil that is present in the water-and-oil emulsion...? What exactly is the effect of the "solubilizer" on the water-and-oil emulsion...? If one adds an emulsifier to a water-and-oil emulsion, this will fundamentally alter the physical structure of the emulsion.



No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton [phone number (703)308-3213].

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



DAVID LUKTON
PATENT EXAMINER
GROUP 1600